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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,150	12/10/2003	Chia Soo	62855.4	8266
7590	06/01/2007			
Zhaoyang Li Squire, Sanders & Dempsey L.L.P. Suite 300 One Maritime Plaza San Francisco, CA 94111			EXAMINER EPPS FORD, JANET L	
			ART UNIT 1633	PAPER NUMBER
			MAIL DATE 06/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/733,150	SOO, CHIA	
Examiner	Art Unit		
Janet L. Epps-Ford	1633		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 08 March 2007.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-53 is/are pending in the application.  
4a) Of the above claim(s) 1-16 and 28-53 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 17-27 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. \_\_\_\_.  
3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date  
5)  Notice of Informal Patent Application  
6)  Other:

## **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-51 are presently pending. Claims 1-16 and 28-51 are withdrawn from further consideration for the reasons of record. Claims 17-27 are currently under examination.

### ***Claim Rejections - 35 USC § 102***

3. The rejection of claims 17-22 under 35 U.S.C. 102(b) as being anticipated by Ruoslahti et al. (WO 93/09800 A1-see Reference B1 on the IDS filed 7-31-06), is withdrawn in response to Applicant's amendment to the claims.

### ***Claim Rejections - 35 USC § 103***

4. Claims 17-27 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ruoslahti et al. for the reasons of record.
5. Applicant's arguments filed 3-08-2007 have been fully considered but they are not persuasive. Applicants traversed the instant rejection on the following grounds:

The Examiner alleges that the limitation "absent a dermal wound" recited in claim 17 carries no patentability weight because this phrase adds no structural limitation to the claimed composition. Applicants respectfully disagrees. For example, reduction of scarring in a dermal wound is associated with the dermal wound healing process and directed to inhibit overgeneration of disorganized dermal matrix. In contrast, a skin absent dermal wound may not involve a dermal wound healing process. Therefore, WO 800 would not lead an ordinary skill in the art to the composition defined by claim 17 for skin regeneration of a mammal skin absent a dermal wound, and claim 17 is not obvious over WO 800. As such, claim 17 is patentably allowable over WO 800 under 35 U.S.C. 103(a). Claims 18-27 depend from claim 17 and are patentably allowable over WO 800 under 35 U.S.C. 103(a) for at least the same reason.

Furthermore, Applicants argue that Ruoslahti et al. does not disclose compositions including a proteoglycan from about 0.0001% to about 10% by weight of the total composition can be effective for skin regeneration of a mammal absent a dermal wound.

The examiner interprets Applicant's arguments to infer that because the instantly claimed compositions do not require the presence of a scar or dermal wound, the claimed compositions differ from the compositions of Ruoslahti et al. Contrary to Applicant's assertions, since the prior art compositions comprise the same components as Applicant's compositions, particularly a proteoglycan compound selected from FM, lumican, decorin, biglycan, and combinations thereof, absent evidence to the contrary, the prior art anticipates the instant claims despite the intended use recited in the claims. A recitation of an intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Ruoslahti et al. discloses compositions for the prevention or reduction of scarring by administration of compositions comprising decorin or a functional equivalent of decorin, to a wound (see page 5, lines 17-26). Functional equivalents of decorin include the following (see page 14, lines 21-28):

Functional equivalents of decorin include modifications of decorin that retain its functional characteristics and molecules that are homologous to decorin, such as biglycan and fibromodulin, for example, 25 that have the similar functional activity of decorin. Modifications can include, for example, the addition of one or more side chains that do not interfere with the functional activity of the decorin core protein.

Fibromodulin is clearly disclosed as useful in the compositions of Ruoslahti et al., wherein said compositions are used for skin care. Moreover, to the extent that the compositions of Ruoslahti et al. are useful to “*prevent*” scarring, the compositions are interpreted as useful in the absence of a dermal wound.

As stated in the prior Office Action, it would have been obvious to the ordinary skilled artisan at the time of the instant invention to modify the teachings of Ruoslahti et al. to comprise the various weight percentages of the individual components in the design of the instant invention. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). See MPEP § 2144.05 [R-5], which states: “[G]enerally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical.” In the instant case, there is no evidence of unexpected results in regards to skin regeneration in the absence of a dermal wound, associated with compositions comprising a range from about 0.0001% to about 10% proteoglycan that will support

applicant's claim of patentability over the compositions of Ruoslahti et al. Applicant's arguments do not take the place of evidence of unexpected results.

***Claim Rejections - 35 USC § 112***

6. The rejection of claims 23-27 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is withdrawn in response to Applicant's amendment. However, due to Applicant's amendment filed 3-08-07, a new grounds of rejection is set forth below.

7. Claims 23-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Instant claims 23-27 depend from claim 17. Claims 23-27 recite: "the skin care composition of claim....comprising: a) from about 0.1 to about 80% by weight....enriched with the proteoglycan compound." However, there is lack of antecedent basis for the range "from about 0.1 to about 80%" in claim 17, which recites the range of 0.0001% to about 10% proteoglycan by weight of the total composition.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 10:00 AM through 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Janet L. Epps-Ford, Ph.D.  
Primary Examiner  
Art Unit 1633

JLE